

REMARKS

This Amendment is submitted in response to the Office Action dated June 23, 2003. In the Office Action, the Patent Office objected to Claims 9, 11, 14-17 and 19 under 35 U.S.C. §112, first and second paragraphs, for failing to comply with the written description requirement and for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Also, in the Office Action, the Patent Office rejected Claims 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* (U.S. Des. Patent No. 286,650) in view of *Martin et al.* (U.S. Patent No. 1,134,691).

By the present Amendment, Applicant amended Claims 9, 14, 15 and 17 and the specification. Applicant submits that the amendments to the claims and the specification overcome the objections and rejection thereto as made by the Patent Office and places the application in condition for allowance.

With respect to the objections to Claims 9, 11, 14-17 and 19 under U.S.C. §112, first and second paragraphs, the Patent Office objected to the use of the limitation "covering" in independent Claims 9, 15 and 17 alleging that the sheath "covering" the body is considered to be new matter. In the Office Action, the Patent Office suggested amending Claim 9 to define a sheath "partially covering" the body of the marking device. The Patent Office states that a sheath "partially covering" the body would be more accurate and would not be

considered new matter. Further, the Patent Office objected to the recitation of "the clamp" in Claim 14 for lack of antecedent basis.

In response to these objections, Applicant amended Claims 9, 14, 15 and 17 and the specification to conform with the suggestions of the Patent Office. Applicant asserts that no new matter has been entered into this application by the amendments to Claims 9, 14, 15 and 17 and the specification. Further, Applicant asserts that the amendments to Claims 9, 14, 15 and 17 and the specification overcome the rejections under 35 U.S.C. §112, first and second paragraphs. Accordingly, Applicant asserts that these claims are now in allowable form. Notice to that effect is requested.

With respect to the rejection of Claims 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.*, Applicant submits that this rejection is improper for the reasons that follow.

Fischer is a design patent which discloses a sleeve for a writing instrument. The Patent Office alleges that *Fischer* discloses a stitching of a sleeve which removably secures the sleeve around a barrel of a marking device and is effectively a "clamp". Additionally, the Patent Office admits that *Fischer* does not disclose a sheath having an antibacterial substance thereon.

Moreover, the Patent Office alleges that page 7, line 17 of Applicant's specification discloses that antibacterial

substances are commonly used to coat surfaces to render the surface sanitary. Additionally, the Patent Office alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to coat the sheath in the *Fischer* device with an antibacterial coating to render the device sanitary.

Contrary to the assertions of the Patent Office, the specification at page 7, lines 14-17 merely teaches that "the antimicrobial agent may be contained within the material used to construct the sheath 10 and not necessarily contained merely upon the surface 18 of the sheath 10." The specification of the present invention merely discloses that "the sheath may have a surface having an antimicrobial agent." Additionally, the specification of the present invention discloses that "the antimicrobial agent may produce an actively sterile surface that kills bacteria, viruses and other like microbes and disease-causing agents." Nowhere does the specification of the present invention teach or suggest that antibacterial substances are commonly used to coat a marking device and/or a sheath of a marking device to render the surfaces sanitary.

Further, the Patent Office alleges *Martin et al.* teach a marking device accessory kit having a marking device covered by a sheath wherein the sheath is secured to the marker by "clamps". Still further, the Patent Office alleges that *Martin et al.* teach an end cap removably attached to the second end of the marking device and a connecting lead from the cap to enable

the marker to be conveniently stored and secured when not in use.

However, independent Claim 17, as amended, requires a method of using a marking device having the step of providing a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark. Further, Claim 17 requires a step of providing a sheath that partially covers the barrel between the first end and the second end wherein the sheath is coated with an antimicrobial substance.

Martin et al. merely teach a pencil having a clasp which is suspended from a flexible stem. Additionally, *Martin et al.* do not teach or suggest a marking device having a sheath that partially covers the barrel between the first end of the barrel and the second end of the barrel wherein the sheath is coated with an antimicrobial substance as required by Claim 17. Further, *Martin et al.* do not teach or suggest a marking device having a sheath which fits over the barrel between the first end of the barrel and the second end of the barrel as required by Claim 17.

Fischer merely teaches a sleeve for a writing instrument. *Fischer* does not teach or suggest a marking device having a sheath that partially covers the barrel between the first end of the body and the second end of the body wherein the sheath is coated with an antimicrobial substance as required by Claim 17. Further, *Fischer* does not teach or suggest a marking device

having an end cap which fits over the second end of the barrel wherein the end cap has a connecting lead that extends from the end cap as required by Claim 17. Moreover, *Fischer* does not teach or suggest a marking device having an end cap which fits over the second end of the barrel as required by Claim 17.

Neither *Fischer* nor *Martin et al.*, taken singly or in combination, teach or suggest a marking device having a sheath which partially covers the barrel between the first end of the barrel and the second end of the barrel wherein the sheath is coated with an antimicrobial substance as required by Claim 17.

Moreover, one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Fischer* with *Martin et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Applicant submits that the Patent Office is merely "piecemealing" references together, providing various teachings and positively defined limitations of Applicant's method of using a marking device to deprecate Applicant's invention. Of course, hindsight reconstruction of Applicant's invention is impermissible.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements

somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's method for using a marking device. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). Moreover, Applicant submits that absolutely no teaching, suggestion and/or incentive exists in the U.S. Design Patent to *Fischer* to combine *Fischer* with *Martin et al.* in the manner suggested by the Patent Office.

With the analysis of the deficiencies of *Fischer* and *Martin et al.* in mind, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Applicant's invention would have been led to combine *Fischer* with *Martin et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent

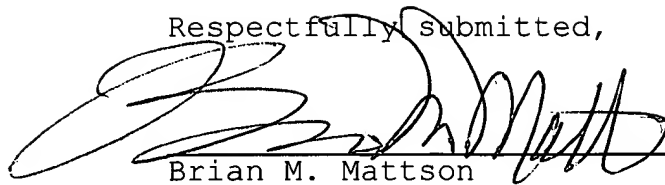
Office, the resultant combination still lack the novel steps positively recited in Claim 17. Namely, neither *Fischer* nor *Martin et al.*, taken singly or in combination, teach or suggest a marking device having a sheath that partially covers the barrel between the first end and the second end wherein the sheath is coated with an antimicrobial substance as required by Claim 17. Accordingly, the rejection of Claims 17 and 19 by the Patent Office under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Claim 19 depends from Claim 17. This claim is further believed allowable over the references of record for the same reasons set forth with respect to its parent claim since it sets forth an additional novel step of Applicant's novel method for using a marking device.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the

application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 20, 2003.



Brian M. Mattson